



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JONES DAY
222 EAST 41ST ST
NEW YORK NY 10017

COPY MAILED

MAR 15 2010

In re Application of :
Briton, et al. :
Application No. 10/722,733 : DECISION ON PETITION
Filed: November 25, 2003 : UNDER 37 CFR 1.182
Attorney Docket No. 11767-055-999 :
:

This is a decision on the “THIRD REQUEST FOR RECONSIDERATION OF DECISION ON PETITION UNDER 37 C.F.R. §1.182”, filed July 16, 2009, requesting entry of an Application Data Sheet (ADS) to insert a reference to an earlier-filed application pursuant to the provisions of 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the ADS.

The petition is **DISMISSED**.

The above-noted **abandoned** application failed to make a specific reference to the prior-filed application; namely, that it is a continuation-in-part of 09/623,548, filed September 5, 2000, prior to abandonment.¹ In a petition filed June 30, 2008, petitioner requested that the instant abandoned application be amended by inserting a reference to the earlier-filed application. However, the petition was dismissed in a decision mailed on September 2, 2008. The decision acknowledged that 35 U.S.C. § 120 permits entry of a subsequent amendment or ADS to an abandoned application in applications filed prior to November 29, 2000 to include the benefit of an earlier filing date for purposes other than prosecution. See Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136 (D.D.C. 1976). However, the decision noted that as the instant application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3) was required.

Petitioners filed a request for reconsideration on October 31, 2008. Petitioners argued that a petition under 37 CFR 1.78(a)(3) is not required where applicants seek to change the relationship of the applications, citing MPEP 201.11(v). Petitioners argued that a mere change in the

¹ The application became abandoned for failure to file a reply to the non-final Office action mailed December 29, 2004.

relationship is what was sought – to amend the application to indicate that it is a continuation-in-part, rather than a continuation, of application No. 09/623,548. However, that petition was dismissed in a decision mailed on December 19, 2008. The decision acknowledged that it was true that if the instant application was in pendency status, then a petition under 37 CFR 1.78 would not be required to change the relationship between the applications. As set forth in MPEP 201.11(III)(A), the reference must state the proper relationship. On filing, both the specification and the ADS stated that the present application “claims priority to US Application No. 09/623,548”. Thus, the change that petitioners are attempting to make is not merely a correction of the relationship. While the USPTO noted the 09/623,548 application on the filing receipt, the incorrect relationship was inserted. While a petition under 37 CFR 1.78 is unnecessary where the USPTO picks up the priority claim, if the USPTO picks up the priority claim and as a result of ambiguity in the claim the incorrect relationship is inserted on the filing receipt, a petition under 37 CFR 1.78 is necessary.

With a second request for reconsideration filed February 5, 2009, petitioners argued that they did file a paper with the application that included a relationship between the applications. Petitioner pointed out that the “REQUEST TO TRANSFER SEQUENCE LISTING FROM RELATED APPLICATIONS”, filed on November 25, 2003, included the following language: “Applicants assert that the present application is a continuation of U.S. Application Serial Nos. 10/288,340 and 09/623,548....” Petitioners cited MPEP 201.11(V), which states in part:

If an applicant includes a claim to the benefit of a prior application elsewhere in the application but not in the manner specified in 37 CFR 1.78(a)(2)(i) and (a)(2)(iii) or 37 CFR 1.78(a)(5)(i) and (a)(5)(iii) (e.g., if the benefit claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a)(2)(ii) or (a)(5)(ii), the Office will not require a petition and the surcharge under 37 CFR 1.17(t) to correct the benefit claim if the information concerning the benefit claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt.

In a decision mailed on May 19, 2009, the Office noted that Petitioners’ argument with respect to this matter had been considered and found to be persuasive. If the instant application were in pendency status, then petitioners were correct – no petition under 37 CFR 1.78 would be required to change the relationship between the applications, since petitioners did include a relationship elsewhere in the application on filing. However, as stated elsewhere in MPEP 201.11(V), “[i]f the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the benefit claim of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c) must be made during the **pendency** of the application.”

In the second request for reconsideration filed February 5, 2009, Petitioners repeated the prior argument that Sampson v. Commissioner of Patents and Trademarks, 195 U.S.P.Q 136 (D.D.C. 1976) permits entry of an Amendment or ADS in an abandoned application. However, the May 19, 2009 decision pointed out that this was only true with respect to applications filed prior to November 29, 2000. In applications filed on or after November 29, 2000, 37 CFR 1.78 is explicit that a claim for priority must be made during the pendency of the later filed application. Petitioners were directed to the Office’s publication found at “Eighteenth-Month Publication

Questions and Answers" (<http://www.uspto.gov/web/offices/dcom/olia/aipa/18monthfaq.htm#cx4>):

CX14. Can applicant add a benefit claim of a prior-filed non-provisional application in a later-filed copending application that has been **abandoned** without filing a petition to revive the later-filed application? (added 4Feb2005)

Yes, a petition to revive the later-filed application is not required when applicant is adding a benefit claim by filing an amendment (or an application data sheet) to add the specific reference of the prior-filed non-provisional application. **A petition under 37 CFR 1.78(a)(3), however, is required if the later-filed application is a utility or plant application filed on or after November 29, 2000. If the later-filed application is a utility or plant application filed before November 29, 2000, a petition under 37 CFR 1.182 is required** (emphasis added).

With his third request for reconsideration, petitioners once again request that the instant application be amended to indicate that it is a continuation-in-part, rather than a continuation, of prior-filed application No. 09/623,548. The crux of petitioners' argument is that they are not adding a benefit claim, but merely correcting an already existing, timely submitted benefit claim. Petitioners cite to CX6 of the "Eighteenth Month Publication Questions and Answers", which states that no petition under 37 CFR 1.78(a)(3) is required when applicant is changing the relationship, e.g. from "continuation" to "continuation-in-part". However, CX6 is silent with respect to the issue of whether a petition is required if the application sought to be amended is an abandoned application. Petitioners state that the USPTO has provided no basis for requiring a petition under 37 CFR 1.78(a)(3) to correct a timely made benefit claim merely because of the abandoned status of the application.

On the contrary, the authority is contained within 35 U.S.C. §120 itself, which states in pertinent part:

No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time **during the pendency of the application** as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section (emphasis added).

As such, petitioners are not entitled to amend the instant application to reflect that it is a "continuation in part" of application No. 09/623,548, rather than a "continuation", because petitioners have not submitted an amendment or ADS in the instant application during its pendency.

Any inquiries concerning this decision may be directed to Petitions Attorney Cliff Congo at (571) 272-3207.



Anthony Knight
Supervisor
Office of Petitions